

### REMARKS

Claims 1-27 are pending in the present application. Applicants have amended Claims 1, 3-6, 18-21 and 25-27 herewith. Reconsideration of the claims is respectfully requested.

#### **I. 35 U.S.C. § 102, Anticipation**

The Examiner rejected Claims 24-26 under 35 U.S.C. § 102(b) as being anticipated by Farnsworth et al. (5,121,371) (hereinafter "Farnsworth"). This rejection is respectfully traversed.

With respect to Claim 24 (and dependent Claims 25 and 26), Applicants urge that the cited Farnsworth reference does not teach the claimed feature of "wherein the direction and magnitude of offset of the track is determined based on the relative locations of the at least two spots with respect to the track". As can be seen, this feature recites that *both the direction and the magnitude* of track offset are determined. In contrast, the cited Farnsworth reference teaches generation of a servo error signal (col. 3, lines 42-54), which is not described as being any type of determination of both direction and magnitude of track offset, as expressly recited in Claim 1. For a prior art reference to anticipate in terms of 35 U.S.C. 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). As shown above, every element of the claimed invention is not identically shown in a single reference, and thus Claim 24 (and dependent Claims 25 and 26) is not anticipated by the cited reference.

Applicants have amended Claims 25 and 26 herewith in accordance with the embodiment described at page 10, line 12 – page 11, line 15. The cited reference does not teach such inter-spot relationships, and thus it is further shown that Claims 25 and 26 are not anticipated by the cited reference.

Therefore, the rejection of Claims 24-26 under 35 U.S.C. § 102 has been overcome.

II. 35 U.S.C. § 103, Obviousness

A. The Examiner rejected Claims 1-3, 21 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Farnsworth in view of Roth et al. (4,958,245) (hereinafter "Roth"). This rejection is respectfully traversed.

Claims 1 and 21 are being amended herewith to include similar features to those recited in original Claim 4, and the rejection of amended Claims 1 and 21 are traversed for reasons given below with respect to original Claim 4.

Applicants traverse the rejection of Claims 2-3 and 23 for reasons given above with respect to Claims 1 and 21, of which Claims 2-3 and 23 respectively depend upon.

Therefore, the rejection of claims 1-3, 21 and 23 under 35 U.S.C. § 103 has been overcome.

B. The Examiner rejected Claims 4-5, 18-20 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Farnsworth and Roth as applied to claims 1-3, 21 and 23 above, and further in view of Smith (6,275,349) (hereinafter "Smith"). This rejection is respectfully traversed.

In rejecting original Claim 4, the Examiner states that the teachings of Farnsworth in combination with the teachings of Roth in combination with the teachings of Smith results in the claimed invention being obvious. Applicants urge that the Examiner is using improper hindsight analysis in such claim rejection. It is error to reconstruct the patentee's claimed invention from the prior art by using the patentee's claims as a "blueprint". When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from the invention itself. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. "...absence of such suggestion to combine is dispositive in an obviousness determination". *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 42 USPQ2d 1378 (Fed. Cir. 1997). There is simply no reason for the combination other than the hindsight obtained from the invention itself. Thus, the Examiner must be using the present invention as the motivation to combine

these three references, which is improper hindsight analysis. Thus, original Claim 4 is shown to have been erroneously rejected.

As to amended Claim 4 (which is being amended herewith), Applicants urge that none of the cited references teach or suggest the claimed feature of "wherein the first detector detects a first spot and the second detector detects a second spot, the second spot being offset from the first spot in a transverse direction by approximately one-quarter of a track spacing between successive tracks on the recording medium", which advantageously provides for determination of both direction and magnitude of offset (Specification page 9, lines 2-18 and page 10, line 12 – page 11, line 15).

Applicants traverse the rejection of Claim 5 for reasons given above with respect to amended Claim 1 (of which Claim 5 depends upon).

Applicants traverse the rejection of Claims 18-20 for reasons given above with respect to Claim 1 (of which Claims 18-20 depend upon).

Applicants traverse the rejection of Claim 22 for reasons given above with respect to Claim 21 (of which Claim 22 depends upon).

Therefore, the rejection of Claims 4-5, 18-20 and 22 under 35 U.S.C. § 103 has been overcome.

C. The Examiner rejected Claims 6-7 under 35 U.S.C. § 103(a) as being unpatentable over Farnsworth, Roth and Smith as applied to Claims 4-5, 18-20 and 22 above, and further in view of Leonhardt et al. (6,084,740) (hereinafter "Leonhardt"). This rejection is respectfully traversed for reasons given above with respect to Claim 1, of which these Claims 6-7 respectively depend upon.

Therefore, the rejection of Claims 6-7 under 35 U.S.C. § 103 has been overcome.

### **III. Objection to Claims**

The Examiner stated that Claim 27 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response, the claim has been rewritten accordingly to overcome this objection.

**IV. Allowance of Claims**

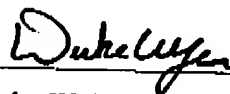
Applicants graciously acknowledge the allowance of Claims 8-17.

**V. Conclusion**

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: 2/16/05

Respectfully submitted,



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